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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,845	10/18/2001	Samy Ashkar	CMCC 779	7069

23579 7590 02/15/2006

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EXAMINER

DEBERRY, REGINA M

ART UNIT PAPER NUMBER

1647

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/981,845	Applicant(s) ASHKAR ET AL.	
	Examiner Regina M. DeBerry	Art Unit 1647	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 08 November 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-3,5 and 6.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.


 MARIANNE P. ALLEN
 PRIMARY EXAMINER

AW/647

2/13/06

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1-3, 5-6 remain rejected under 35 USC 112, first paragraph, scope of enablement, while being enabling for an active osteopontin peptide fragment comprising the amino acid of SEQ ID NO:11, wherein the peptide increases cell attachment of osteoprogenitor cells to a material and increases cell spread of osteoprogenitor cells, does not reasonably provide enablement for the instant claims as recited. The rejection is maintained for reasons of record (pages 2-7 of the previous Office Action, 08 August 2005).

Applicant discusses the claimed invention, the legal standard for enablement and various case law. Applicant argues that Example 12 and Table 8 from the instant specification demonstrates that plates coated with SEQ ID NOs:9-15 bind to osteoprogenitor cells and that there are art recognized techniques for determining the integrin expression profile of the cell.

Applicant's arguments have been fully considered but are not deemed persuasive. The Examiner stated in the previous Office Action that NO integrin receptor was identified for SEQ ID NO:11 (the elected SEQ ID NO:) and ONLY SEQ ID NO:15 was shown to bind alpha5beta3 integrin receptor. Hu et al. (reference submitted by Applicant) teach that the highest expression of alpha5beta3 integrin receptor is in osteoclasts. Tuck et al. (reference submitted by Applicant) teach that osteopontin binds alpha5beta3 in MDA-MB-435 cell lines, but does not bind alpha5beta3 in 21PT and 21NT cell lines. This demonstrates that cells express different levels of integrin receptors.

The scope sought by Applicant as defined by the claims fails to bear a reasonable correlation with the scope of the enabling disclosure set forth in the specification. It would require an indeterminate quantity of unpredictable investigational experimentation of the skilled artisan to determine which cell type expressed which integrin receptor, then discern if that cell type expressing that specific integrin receptor bound surfaces coated with the various SEQ ID NOs. The instant claims recite a genus of various cell types and integrins but the specification only discloses a species. Since Applicant has failed to present new evidence, claims 1-3, 5-6 stand rejected under 35 USC 112, first paragraph, scope of enablement.